

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Richard L. Franklin	: Confirmation No.: 4994
	:
Application Serial No.: 10/750,184	: Group Art Unit: 1648
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Filing Date: December 31, 2003	: Examiner: Zachariah Lucas
	:
For: REMOVING DENTAL PLAQUE	: Attorney Docket No: ARC-1001USCON1
WITH KRILL ENZYMES	:

**REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT**

Mail Stop: Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is a request for reconsideration of the patent term adjustment indicated in the Determination of Patent Term Adjustment under 35 U.S.C. §154(b) mailed on September 30, 2010 in relation to the above-mentioned application. The fee set forth in 37 C.F.R. 1.18(e) accompanies this request.

This patent is not subject to a terminal disclaimer. The applicant concedes that there were circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination as set forth in the patent term adjustment calculation for the above-mentioned application on September 1, 2010 (delay in filing the Notice of Appeal – 92 days), December 11, 2009 (Delay in filing the response after non-final action - 90 days), April 1, 2009 (Filing a supplemental response – 43 days) and July 17, 2008 (Delay in filing the Notice of Appeal – 91 days).

The sole purpose of this request is to challenge the patent term adjustment reduction of 457 days from September 6, 2006 to December 7, 2007 pursuant to 37 C.F.R. §1.704(c)(8) based on the filing of a Supplemental Response on December 7, 2007. The Supplemental Response filed on December 7, 2007 actually expedited prosecution of the application rather than delayed prosecution of the application and thus should not be considered as a failure to engage in reasonable efforts to conclude processing or examination for the reasons set forth

below. Favorable consideration and reinstatement of 457 days of patent term adjustment are thus requested.

The 457 day patent term adjustment reduction on December 7, 2007, was based on 37 C.F.R. §1.704(c)(8) which deems the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the Examiner, after a reply has been filed, to constitute a failure to engage in reasonable efforts to conclude processing or examination. In MPEP §2732, it is further explained in relation to a reduction under 37 C.F.R. §1.704(c)(8) that submission of a supplemental reply after an initial reply was filed requires the Office to restart consideration of the initial reply in view of the supplemental reply or other paper which will result in a delay in the Office's response to the initial reply. It is on this basis that submission of a supplemental reply or other paper is deemed to constitute a failure to engage in reasonable efforts to conclude processing or examination.

It is submitted that although the applicant submitted a paper on December 7, 2007 which was not requested by the Examiner, the submission of this paper did not require the Office to restart consideration of the initial reply and, in fact, this submission expedited the processing of the application by obviating the need for the Office of Petitions to deny the petition under 37 C.F.R. 17.8(a) (3) to accept an unintentionally delayed claim under 35 U.S.C. 120 and 365(c) for the benefit of priority, which was filed on August 23, 2006 (hereinafter "the Petition") which was still awaiting a decision by the Office of Petitions on December 7, 2007. As a result, since no actual delay in prosecution resulted from the paper submitted on December 7, 2007 and, in fact, the submission of this paper expedited prosecution by allowing the immediate grant of the Petition, the circumstances surrounding the submission of the paper on December 7, 2007 did not constitute a failure to engage in reasonable efforts to conclude processing or examination.

On or about December 7, 2007, during a routine status check, applicant's attorney, Kevin J. Dunleavy, the author of this request, discovered that the application was still lodged in the Office of Petitions awaiting a decision on the Petition. In the course of this status check, applicant's attorney, Kevin J. Dunleavy, also discovered an inadvertent typographical error in the amendment that had been filed on August 23, 2006 concurrently with the Petition in order to meet the requirement for the reference to the prior applications under 35 U.S.C. §120 and 37 C.F.R. §1.78(a) (2)(i) for the grant of the Petition. Specifically, the filing date of International

Application no. PCT/SE93/00455, to which benefit was claimed, was inadvertently indicated as being May 21, 2003 rather than the correct filing date of May 21, 1993. Applicant's representative determined that it was likely that the Petition would be dismissed for failure to provide the correct reference required by 35 U.S.C. §120 and 37 C.F.R. §1.78(a) (2)(i) due to this inadvertent typographical error.

Thus, the sole purpose of the paper submitted on December 7, 2007 was to correct this inadvertent typographical error in order to avoid dismissal of the Petition for failure to provide the correct reference required by 35 U.S.C. §120 and 37 C.F.R. §1.78(a) (2)(i). The applicant's representative succeeded in this goal since the Petition was, in fact, granted on January 14, 2008. If the paper submitted on December 7, 2007 had not been submitted, further delay would have resulted since the Petition would have been dismissed for failure to provide the correct reference required by 35 U.S.C. §120 and 37 C.F.R. §1.78(a) (2)(i), the applicant would then have had to request reconsideration of the dismissal and amend the application to correct the inadvertent typographical error and the Office of Petitions would then have had to rule on the request for reconsideration. The paper submitted on December 7, 2007 obviated the need for these additional steps to grant the Petition, thereby expediting prosecution of the application.

In addition, since the application was still lodged in the Office of Petitions on December 7, 2007, the Examiner had not yet begun consideration of the applicant's previous response of September 6, 2006 at the time of filing the paper on December 7, 2007. This is confirmed by the fact that the consideration of the September 6, 2006 response by the Examiner was contingent on a ruling on the Petition since the Office Action of July 6, 2006 raised the issue as to whether the applicant was, in fact, entitled to its claims to benefit of the earlier applications (See pages 5-6 of the Office Action of July 6, 2006). In order for the Examiner to make a final determination on this issue, it was first necessary for the Office of Petitions to rule on the Petition since the Petition was filed for the purpose of making an unintentionally delayed claim to priority. The Decision on Petition dated January 14, 2008 takes note of this fact on page 2 where it states that, "This application is being referred to Technology Center Art Unit 1648, for consideration by the examiner of applicant's entitled to claim benefit of priority under 35 U.S.C. §§ 120 and 365(c) to the prior-filed applications." Accordingly, since the ruling on the Petition was a precondition to the examiner's consideration of the applicant's entitlement to claim benefit of priority, the submission of December 7, 2007 actually expedited prosecution

by expediting the granting of the Petition thereby enabling the Examiner to make a final substantive ruling on the issue of entitlement to priority.

As a result, the submission of the paper on December 7, 2007 did not require the Examiner to restart consideration of the initial reply of September 6, 2006, since the Examiner had not yet begun consideration of the initial reply of September 6, 2006 because a ruling on the Petition was a pre-condition to the Examiner's consideration of the September 6, 2006 reply. It is noted, for example, that PAIR indicates that the examiner did not conduct the initial prior art search on the present application until January 15, 2008, after the Decision on Petition. This confirms that the examiner was not required to restart consideration of the September 6, 2006 response as a result of the December 7, 2007 submission since the Examiner had not conducted the initial prior art search and the Decision on Petition was a pre-condition for consideration of the September 6, 2006 response, as discussed above. This also indicates that the December 7, 2007 submission actually facilitated the examiner's handling of the application since it resulting in granting of the petition, thereby enabling the examiner to greatly reduce his search burden by limiting the search to prior art prior to the claimed priority benefit date of the application i.e. May 22, 1992, rather than having to search prior art up until the actual filing date of the application of December 31, 2003.

Accordingly, the underlying basis for deeming the submission of the paper on December 7, 2007 to be a failure to engage in reasonable efforts to conclude examination, as set forth in MPEP §2732, is not present in the present application since the Examiner was not required to restart consideration of the September 6, 2006 response due to the December 7, 2007 submission because the application was still lodged in the Office of Petitions on December 7, 2007 and the examiner had not yet begun examination or even conducted the initial prior art search on the application until January 15, 2008.

Finally, in the Decision on Petition dated January 14, 2008, the Office of Petitions specifically stated in the opening paragraph of its decision on the Petition filed August 23, 2006 that, "The delay in responding is regretted." Thus, the Office of Petitions actually took responsibility for the delay in prosecution of the application from August 23, 2006 until January 14, 2008. Under these circumstances it would be unfair the applicant and contrary to the intent of 37 C.F.R. §1.704(c)(8) to reduce the patent term by 457 days for the filing of a paper that:

- (1) did not require restarting of consideration by the Examiner since the application was in the Office of Petitions for the period in question and the examiner had not yet performed the initial prior art search,
- (2) corrected a minor typographical error,
- (3) expedited prosecution by allowing immediate grant of the Petition rather than awaiting dismissal of the petition for the purpose of correcting the error,
- (4) facilitated the examiner's work by correcting the priority benefit claims thereby reducing the number of issues and the body of prior art for consideration by the examiner during prosecution, and
- (5) did not delay prosecution of the application as indicated by the Office of Petitions' apology for the delay in the first paragraph of the January 14, 2008 Decision on Petition.

Accordingly, favorable consideration and reinstatement of 457 days of patent term adjustment for the above-mentioned application is requested. Once the 457 days of patent term adjustment is reinstated, the correct patent term adjustment for this application is 508 days, namely, the 51 days of patent term adjustment indicated in the Determination of Patent Term Adjustment under 35 U.S.C. §154(b) mailed on September 30, 2010 plus the 457 days of patent term adjustment requested herein.

Date: December 29, 2010

Respectfully submitted,

/Kevin J. Dunleavy/  
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